UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/995,224	11/26/2001	Adrian Conor Klein	MSFT-0672/158461.1	9650

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EXAMINER
RIES, LAURIE ANNE

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/995,224	KLEIN ET AL.
	Examiner	Art Unit
	Laurie Ries	2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>*04 February 2005*</u>.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>*1-23*</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>*1-23*</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: amendment, filed 4 February 2005, to the

    original application filed 26 November 2001.

2. The objection to the specification has been withdrawn as necessitated by amendment.

3. The objection to claims 6, 12, and 21 has been withdrawn as necessitated by amendment.

4. The rejection of claims 7-8 and 22-23 has been withdrawn as necessitated by amendment.

5. The rejection of claims 1-2, 4, 7, 10-12, 15-20 and 22 under 35 U.S. C. 102(e) has been

    removed as necessitated by amendment and newly found prior art.

6. Claims 1-9 and 21 remain rejected under 35 U.S.C. 101.

7. Claims 1-23 are pending. Claims 1, 12, and 21 are independent claims.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and
requirements of this title.

Claims 1-9 and 21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to

non-statutory subject matter.

Claims 1-9 and 21 are directed to software programs, per se, not tangibly embodied in a

computer readable medium.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

Claims 1-4, 7, 10, 10-12 and 15-20 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Goodisman (U.S. Publication 2002/0069223 A1) in view of Subramanian

(U.S. Publication 2002/0123912 A1).

As per claims 1 and 12, Goodisman discloses a system and method for providing

associated links in content viewable by a computing browser-type application capable of

receiving and displaying content including receiving online content by a computing application

from a cooperating content server over a communications network (See Goodisman, Page 3,

paragraphs 0032-00330, a recognizer, or pattern matcher, that cooperates with a linkify engine or

helper object to compare the content with a predefined list of key-phrases and/or syntactic rules

for recognizing key-phrase candidates. (See Goodisman, Page 6, paragraph 0053). Goodisman

does not disclose expressly a helper object that does not cooperate with any other content

viewing application. Subramanian discloses a Match Maker, equivalent to the helper object of

the Instant Application, whose function is to parse the content of the current page, group

attributes to form structured objects, communicate with the Rules Registry, and produce a set of

contextually relevant advertisements (See Subramanian, Page 7, paragraph 0102, and Page 10,

paragraph 0133). Goodisman and Subramanian are analogous art because they are from the

same field of endeavor of linking data. At the time of the invention it would have been obvious

to a person of ordinary skill in the art to include the Match Maker of Subramanian with the

system and method for providing associated links of Goodisman. The motivation for doing so

would have been to affiliate links that are automatically determined to be relevant to the

customer's current interest on the Internet (See Subramanian, Page 1, paragraph 0002).

Therefore, it would have been obvious to combine Subramanian with Goodisman for the benefit

of affiliating links that are automatically determined to be relevant to the customer's current

interest on the Internet to obtain the invention as specified in claims 1 and 12.

As per claim 2, Goodisman and Subramanian disclose the limitations of claim 1 as

described above. Goodisman also discloses at least one action handler, or targeting feature, to

execute at least one pre-defined action related to the associated links. (See Goodisman, Page 6,

paragraph 0053, and Page 7, paragraph 0056).

As per claim 3, Goodisman and Subramanian disclose the limitations of claim 1 as

described above. Subramanian also discloses automatically updating the predefined list of key-

phrases and/or syntactic rules (See Subramanian, Page 5, paragraph 0074). Goodisman and

Subramanian are analogous art because they are from the same field of endeavor of linking data.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to

include automatic updating of the database of Subramanian with the system for providing

associated links of Goodisman. The motivation for doing so would have been to access the latest

data whenever the browser is used (See Subramanian, Page 5, paragraph 0074). Therefore, it

would have been obvious to combine Subramanian with Goodisman for the benefit of accessing

the latest data whenever the browser is used to obtain the invention as specified in claim 3.

As per claim 4, Goodisman and Subramanian disclose the limitations of claim 1 as described above. Goodisman also discloses that the computing application includes a content browser computing application. (See Goodisman, Page 6, paragraph 0053).

As per claim 7, Goodisman and Subramanian disclose the limitations of claim 1 as described above. Goodisman also discloses that the associated links offer features including additional associated links, which is included in the list of possible features set forth in claim 7. (See Goodisman, Pages 3-4, paragraph 0037).

As per claim 10, Goodisman and Subramanian disclose the limitations of claim 1 as described above. Goodisman also discloses that the computing browser-type application resides on a client computer of a networked computer environment. (See Goodisman, Figure 3, elements 42 and 48).

As per claim 11, Goodisman and Subramanian disclose the limitations of claim 10 as described above. Goodisman also discloses that the received content is received from at least one computer server of the networked computer environment. (See Goodisman, Figure 3, element 44).

As per claim 15, Goodisman and Subramanian disclose the limitations of claim 12 as described above. Goodisman also discloses executing the match true associated links upon interaction from participating users, the interaction being realized through at least one input from a user interface with the match true associated links. (See Goodisman, Page 3, paragraphs 0035-0036, Page 4, paragraph 0038, and Page 7, paragraph 0059).

As per claim 16, Goodisman and Subramanian disclose the limitations of claim 15 as described above. Goodisman also discloses aggregating content associated with the executed

associated link, the aggregated content including any of a group including additional associated links, additional relevant content related to the executed content, execution commands for search operations, and execution commands to launch cooperating applications (See Goodisman, Page 3-4, paragraph 0037), and generating an interactive display pane, which is populated with the aggregated content. (See Goodisman, Page 3-4, paragraph 0037).

As per claim 17, Goodisman and Subramanian disclose the limitations of claim 12 as described above. Goodisman also discloses separating the received online content into phrases and communicating the phrases to the recognizer, or pattern matcher. (See Goodisman, Page 6, paragraph 0053).

As per claim 18, Goodisman and Subramanian disclose the limitations of claim 12 as described above. Goodisman also discloses processing the phrases to identify any words that are contained in the predefine list of associated links. (See Goodisman, Page 6, paragraph 0053).

As per claim 19, Goodisman and Subramanian disclose the limitations of claim 12 as described above. Goodisman also discloses highlighting the match true associated links such that they appear having a different color and/or format than surrounding non-associated link content. (See Goodisman, Page 6, paragraph 0053).

As per claim 20, Goodisman and Subramanian disclose the limitations of claim 12 as described above. Goodisman also discloses a computer readable medium having computer executable instructions for performing the steps in claim 12. (See Goodisman, Page 7, paragraphs 0060 and 0062).

Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodisman

(U.S. Publication 2002/0069223 A1) in view of Subramanian (U.S. Publication 2002/0123912

A1), as applied to claim 1 above, and further in view of Smith (U.S. Patent 6,222,537 B1).

As per claims 5 and 6, Goodisman and Subramanian disclose the limitations of claim 1 as

described above. Goodisman and Subramanian do not disclose expressly the inclusion of a first

and second listener including a set of instructions to monitor and be responsive to interaction

with the computing application. Smith discloses the use of event listener objects, which include

a set of instructions to monitor and interact with a computing application. (See Smith, Column

8, lines 23-32). Goodisman, Subramanian and Smith are analogous art because they are from the

same field of endeavor of accessing information online. At the time of the invention it would

have been obvious to a person of ordinary skill in the art to include the event listener objects of

Smith with the method and system of providing associated links of Goodisman and

Subramanian. The motivation for doing so would have been to be aware of events triggered by

user interaction. (See Smith, Column 8, lines 28-32). Therefore, it would have been obvious to

combine Smith with Goodisman and Subramanian for the benefit of tracking user interaction to

obtain the invention as specified in claims 5 and 6.

Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodisman

(U.S. Publication 2002/0069223 A1) in view of Subramanian (U.S. Publication 2002/0123912

A1), as applied to claim 7 above, and further in view of Horowitz (U.S. Patent 6,122,647).

As per claims 8 and 9, Goodisman and Subramanian disclose the limitations of claim 7 as

described above. Goodisman and Subramanian do not disclose expressly that the additional

associated links are related to an underlying associated link. Horowitz discloses additional

associated links that are related to an underlying associated link. (See Horowitz, Figure 5).

Goodisman, Subramanian and Horowitz are analogous art because they are from the same field

of endeavor of dynamically generating contextual links. At the time of the invention it would

have been obvious to a person of ordinary skill in the art to include the additional associated

links related to an underlying associated link of Horowitz with the additional associated links of

Goodisman and Subramanian. The motivation for doing so would have been to generate new

links from the target document that may be available or relevant. (See Horowitz, Column 2,

lines 23-29). Therefore, it would have been obvious to combine Horowitz with Goodisman and

Subramanian for the benefit of providing additional relevant links to obtain the invention as

specified in claims 8 and 9.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goodisman (U.S.

Publication 2002/0069223 A1) in view of Subramanian (U.S. Publication 2002/0123912 A1), as

applied to claim 12 above, and further in view of Kippenhan (U.S. Publication 2002/0010769

A1).

As per claim 13, Goodisman and Subramanian disclose the limitations of claim 12 as

described above. Goodisman also discloses displaying the generated processed content to

participating users through a cooperating display device. (See Goodisman, Page 6, paragraph

0053, Figure 3, element 42, and Page 5, paragraph 0050). Goodisman and Subramanian do not

disclose expressly monitoring the activity of the participating users with the match true

associated links of generated processed content to offer content associated with the associated

links. Kippenhan discloses monitoring user activity on a web browser. (See Kippenhan, Page 3,

paragraph 0032). Goodisman, Subramanian and Kippenhan are analogous art because they are

from the same field of endeavor of accessing information online. At the time of the invention it

would have been obvious to a person of ordinary skill in the art to combine the monitoring of

user activity on the browser of Kippenhan with the method of providing associated links of

Goodisman and Subramanian. The motivation for doing so would have been to identify and

provide additional information about a given subject of interest to a user. (See Kippenhan, Page

1, paragraph 0010). Therefore, it would have been obvious to combine Kippenhan with

Goodisman and Subramanian for the benefit of identifying and providing the user with additional

information of interest to obtain the invention as specified in claim 13.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goodisman (U.S.

Publication 2002/0069223 A1) in view of Subramanian (U.S. Publication 2002/0123912 A1) and

Kippenhan (U.S. Publication 2002/0010769 A1), as applied to claim 13 above, and further in

view of Smith (U.S. Patent 6,222,537 B1).

As per claim 14, Goodisman, Subramanian and Kippenhan disclose the limitations of

claim 13 as described above. Goodisman, Subramanian and Kippenhan do not disclose

expressly the inclusion of a first and second listener including a set of instructions to monitor and

be responsive to interaction with the computing application. Smith discloses the use of event

listener objects, which include a set of instructions to monitor and interact with a computing

application. (See Smith, Column 8, lines 23-32). Goodisman, Subramanian, Kippenhan and

Smith are analogous art because they are from the same field of endeavor of accessing

information online. At the time of the invention it would have been obvious to a person of

ordinary skill in the art to include the event listener objects of Smith with the method and system

of providing associated links of Goodisman, Subramanian and Kippenhan. The motivation for

doing so would have been to be aware of events triggered by user interaction. (See Smith,

Column 8, lines 28-32). Therefore, it would have been obvious to combine Smith with

Goodisman, Subramanian and Kippenhan for the benefit of tracking user interaction to obtain the

invention as specified in claim 14.

Claims 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodisman

(U.S. Publication 2002/0069223 A1) in view of Subramanian (U.S. Publication 2002/0123912

A1) and Baird (U.S. Publication 2003/0080986 A1).

As per claim 21, Goodisman discloses a system and method for providing associated

links in content viewable by a computing browser-type application capable of receiving and

displaying content including receiving online content by a computing application from a

cooperating content server over a communications network (See Goodisman, Page 3, paragraphs

0032-00330, a recognizer, or pattern matcher, that cooperates with a linkify engine or helper

object to compare the content with a predefined list of key-phrases and/or syntactic rules for

recognizing key-phrase candidates (See Goodisman, Page 6, paragraph 0053), and an update

engine on a computing application incorporating associated links in online content (See

Goodisman, Claim 34). Goodisman does not disclose expressly a helper object that does not

cooperate with any other content viewing application. Subramanian discloses a Match Maker,

equivalent to the helper object of the Instant Application, whose function is to parse the content

of the current page, group attributes to form structured objects, communicate with the Rules

Registry, and produce a set of contextually relevant advertisements (See Subramanian, Page 7,

paragraph 0102, and Page 10, paragraph 0133). Goodisman also does not disclose

communicating with an update server to obtain data indicative of an updated associated link list.

Baird discloses updating a list of links upon the execution of a preconfigured event. (See Baird,

Page 5, paragraph 0048). Goodisman, Subramanian and Baird are analogous art because they

are from the same field of endeavor of linking data. At the time of the invention it would have

been obvious to a person of ordinary skill in the art to include the Match Maker of Subramanian

and the update engine of Baird with the system and method for providing associated links of

Goodisman. The motivation for doing so would have been to affiliate links that are

automatically determined to be relevant to the customer's current interest on the Internet (See

Subramanian, Page 1, paragraph 0002) and to remove links which have become outdated or are

no longer available. (See Baird, Page 2, paragraph 0021). Therefore, it would have been

obvious to combine Subramanian with Goodisman for the benefit of affiliating links that are

automatically determined to be relevant to the customer's current interest on the Internet and to

remove links which have become outdated or are no longer available to obtain the invention as

specified in claim 21.

As per claim 22, Goodisman, Subramanian and Baird disclose the limitations of claim 21

as described above. Goodisman also discloses modifying the existing predefined associated link

lists to include data on the obtained associated link lists (See Goodisman, Page 6, paragraph

0053).

As per claim 23, Goodisman, Subramanian and Baird disclose the limitations of claim 21 as described above. Goodisman also discloses a computer readable medium having computer readable instructions for performing the steps recited in claim 21. (See Goodisman, Page 7, paragraphs 0060 and 0062).

Response to Arguments

Applicant's arguments regarding the rejection of claims 1-9 and 21 under 35 U.S.C. 101 have been fully considered but they are not persuasive. Applicant states on Page 9 of the Amendment, filed 4 February 2005, that, "the invention can invariably be practiced in hardware **and/or** in software" (emphasis added). If the invention is practiced in software **only**, as Applicant suggests, then the invention is non-statutory because it is directed to software only, and is not tied to a technological art, environment or machine, which would result in a practical application producing a concrete, useful and tangible result to form the basis of statutory subject matter under 35 USC 101.

One technique for satisfying the requirements of 35 USC 101 is to claim code residing in memory (i.e., hardware), wherein that code produces a tangible result.

Applicant's arguments with respect to the rejection of claims 1-23 under 35 U.S.C. 102(e) and 35 U.S.C. 103(a) have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurie Ries whose telephone number is (571) 272-4095. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Field, can be reached on (571) 272-4090.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this action should be mailed to:

> Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(703) 746-7239 (for formal communications intended for entry)

Or:

(703) 746-7240 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Or:

(703) 746-7238 (for after-final communications)

LR
4/30/2005

SANJIV SHAH
PRIMARY EXAMINER